

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 14-17, 19-21 and 23-25 are rejected under 35 USC 102(b) over the U.S. patent to Richardson.

The above listed claims are also rejected under 35 USC 102(b) over the U.S. patent to Nagy, Paul, and Levedahl.

Also, the drawings, the disclosure and the claims are objected to and the claims are rejected under 35 USC 112.

In connection with the Examiner's grounds for the objections and rejections, applicants amended Claims 14 and 20 and Figures 1 and 4, to continue the examination of the present application.

Claims 14 and 20 have been amended to specify the substantially uniform material wall thickness of the detent disk body more precisely. It now makes clear that the uniform material wall thickness is present above the driving device (diameter-wise) and at the detent cams and/or recesses. Such feature is clear in Figures 2, 3 and 4 of the application. This is illustrated by means of Figure 2 as shown in Figure 1.

The areas in which the uniform material wall thickness is provided are highlighted by arrows in Figure 1. It is evident that the bolt thickness is the same above the driving device and at the detent cams. In determining this thickness of the detent disk, the detent cams or recesses are taken into account. This feature is not disclosed in the prior art, because in the prior art the detent disks clearly have a varying wall thickness. This feature alone clearly and patentably distinguishes the present invention from the prior art applied by the Examiner and therefore Claims 14 and 20 can should be considered as allowable over the art even for these reasons.

Claims 14 and 20 have been amended to add another feature. Both claims now define that the outer diameter of the detent disk is reduced at the detent cams and/or recesses. This feature is clearly shown in Figures 1 to 4. This feature is also not disclosed from the prior art applied by the Examiner against the original claims.

It is respectfully submitted that Claims 14 and 20 should be considered as patentably distinguishing over the prior art including the patents to Richardson, Nagy, Paul and Levedahl. None of the references discloses a detent disk with a substantially uniform material wall thickness above the driving device and at the detent cams/recesses nor with a reduced outer diameter of the detent disk at the detent cams/recesses.

Amended Figure 1 shows the hammer tube in a side view and a sectional view of the detent disk and the support gear. The elements (21) and (22) were somewhat modified to better resemble the snap rings, in correspondence with the specification. The reference numeral 10 now indicates the detent disk more precisely. In the amended Figure 4 the reference numeral 15 was corrected to 16 as it indicates the outer diameter. The reference numeral 25 in Figure 3 corresponds to the root circle.

Corresponding reference numerals have been added to the drawings and the specification.

Figures 2-4 illustrate the features of the claims including the above-mentioned new features of the present invention, in particular that the detent disk has a substantially uniform material wall thickness above

(diameter – wise), the driving device and the detent clams/recesses. This is illustrated by Figure 1.

A new reference numeral 5 has been added to amended Figure 1. The reference numeral indicates the overload coupling. In applicant's opinion it is evident for a person skilled in the art that a compression spring, a spur gear and a detent disk that are held together by snap rings constitute an overload coupling.

The amended Claim 1 also defines that the detent cam of the detent disk engages the spur gear in the lower half of the figure. It therefore shows that the spur gear and the detent cams overlap each other in axial direction as defined in Claim 20.

In connection with the Examiner's indication that the term "both" in the claims does not have a support in the specification, the Examiner's attention is respectfully directed to page 3, lines 11-14, where this feature is disclosed. As for Claim 25, this claim defines a machine tool, while Claim 20 defines an overload coupling, and therefore Claim 25 cannot be considered as a duplicate of Claim 20.

All of the above discussed changes have been made with due consideration of the fact that no new matter is added to the application.

Turning again to the Examiner's grounds for the rejection of the claims over the art, it is believed to be clear from the explanations presented hereinabove that the new features of the present invention as defined in Claims 14 and 20 are not disclosed in the references.

The Examiner rejected the claims over the references as being anticipated. In connection with this, it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, none of the references disclose each and every element of the present invention as defined in Claims 14 and 20.

Therefore it is respectfully submitted that the anticipation rejection of the original claims should be considered as not tenable with respect to amended Claims 14 and 20 and should be withdrawn.

The references applied by the Examiner against the original claims also do not contain any hint, suggestion or motivation for the new features of the present invention as defined in Claims 14 and 20. A person skilled in the art would not arrive would never consider the new features of the present invention obvious and would never arrive at the applicant's invention from the teachings of the references. Instead, the references have to be fundamentally modified by including into them the new features of the present invention as now defined in Claims 14 and 20. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Therefore, the present invention as defined in Claims 14 and 20 cannot be considered as obvious from the teachings of the references.

Claims 14 and 20 should be considered as patentably distinguishing over the art and should be allowed.

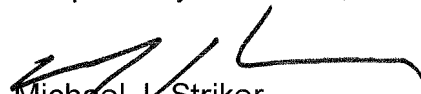
As for the dependent claims, these claims depend on the independent claims, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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